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JGJr: 03-06

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OFFICE OF PETITIONS

In re Application of
Cheong
Application No. 10/747,906
Filed: 29 December, 2003
Attorney Docket No.: 11037-189-999

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ON PETITION

This is a decision on the petition submitted on 7 February, 2006, alleging unintentional delay and requesting revival under 37 C.F.R. §1.137(b).

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

It appears that:

- Petitioners failed to reply timely and properly to a Notice of Allowance and Fees Due as to the drawings requirement of the contemporaneous Notice of Allowability mailed on 16 November, 2004, with reply due under a non-extendable deadline on or before 16 February, 2005;
- the application went abandoned after midnight 16 February, 2005;
- the Office mailed a Notice of Abandonment on 20 May, 2005;

- with the instant petition (with fee), Petitioners paid the fees due as the reply to the 16 November, 2004, Notice(s), and filed and IDA and foreign references.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).¹

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.²

Delays in responding properly raise the question whether delays are unavoidable.³ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁴ And the Petitioner must be diligent in attending to the matter.⁵ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁶))

¹ 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

² Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

³ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁴ See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁵ See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office *supra*.

⁶ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Allegations as to
Unintentional Delay

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

Notably, this application was abandoned for just short of a year before the instant petition was filed. Moreover, almost nine (9) months lapsed between the Notice of abandonment and the filing of the instant petition, with which Petitioners also filed (contemporaneously with the Issue Fee) an IDS.

If the delay in the filing of the instant petition was to await the IDS so as to obtain its consideration without having to withdraw from issue and file a request for continued examination, the delay would not be unintentional.

However, Petitioners Jessica C. Stahnke (Reg. No. 57,570) for/and Thomas D. Kohler (Reg. No. 32,797) represent to the Office that the delay herein was unintentional, and the Office accepts that representation under Petitioners' duty of candor to the Office.⁷

Thus, Petitioners have filed the petition, paid the fee, filed the reply (paid the fees due) and made the statement of unintentional delay.

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center 3700 for consideration of the IDS.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
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Office of Petitions

⁷ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).